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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,387	07/09/2001	David Yan	55131569-5	6510
26453	7590	05/16/2005		
BAKER & MCKENZIE LLP 805 THIRD AVENUE - 29TH FLOOR NEW YORK, NY 10022			EXAMINER BROCKETTI, JULIE K	
			ART UNIT 3713	PAPER NUMBER

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,387

Applicant(s)

YAN ET AL.

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02252002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

1. For some of the inventors it lists the city of residence to be "Moscow Region". The Examiner is unfamiliar with this city. It is requested that Applicant verify that this is an actual city and not just a "region". If it is not an actual city, please supply a new declaration with the actual city of residence listed for each inventor.
2. None of the inventors have dated the declaration. For a proper declaration to be executed, one needs both the inventor's signature and date that it was signed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states "...at least one of the plurality.." in lines 9 and 10. While the Examiner assumes that this "plurality" is meant to refer to the plurality of connector sockets, it is not completely clear. It is suggested that Applicant use the entire phrase of the limitation "the plurality of connector sockets" instead of just "the plurality."

Claim 4 recites the limitation "its side". There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

Claim 3 is rejected under 35 U.S.C. 112, fourth paragraph, as failing to further limit the subject matter of a previous claim. Claim 3 states, "...wherein the cartridge includes another additional connector for directly connecting the additional cartridge". This is exactly what independent claim 1 states; therefore, claim 3 does not further limit the subject matter of claim 1. If Applicant intends to claim a second or third connector, it is advised that they specify how many connectors by number.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu, U.S. Patent No. 5,785,598. Hsu discloses a portable computer device. A microcomputer has a connector socket for directly connecting a cartridge to the microcomputer (See Hsu Figs. 2, 3A; col. 3 lines 53-58). A cartridge has a plurality of connector sockets. At least one of the plurality for connecting the cartridge to the microcomputer and at least another one of the plurality for connecting the cartridge to an additional cartridge (See Hsu col. 3 lines 32-67; Fig. 3A). The microcomputer can execute instructions on the cartridge and the additional cartridge without having to disconnect the cartridge and the additional cartridge (See Hsu col. 2 lines 14-57; col. 5 lines 57-64) [claims 1, 3]. The cartridge and the additional cartridge have equal thickness (See Hsu Fig. 3A) [claim 5]. The cartridge and the additional cartridge have different thickness (See Hsu Fig. 3B) [claim 6]. The cartridge and the additional cartridge have the same dimensions in height, width, and length (See Hsu Fig. 3A) [claim 7]. The cartridge and the additional cartridge have different dimensions in height, width, and length (See Hsu Fig. 3B) [claim 8].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, U.S. Patent No. 5,785,598. Hsu discloses that the connector socket of the cartridge is placed on its side. However, it lacks in disclosing that the additional cartridge when connected is perpendicular to the cartridge. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the additional cartridge be perpendicular to the first cartridge because Applicant has not disclosed that a perpendicular relationship provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Hsu's invention and Applicant's invention, to perform equally well with either connection taught by Nash or the claim 4 connection because no matter how the cartridges are connected they still transmit information. Therefore, it would have been prima facie obvious to modify Hsu as specified in claim 4 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Hsu.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, in view of Studley, U.S. Patent No. 4,596,390. Hsu lacks in disclosing that the microcomputer includes an additional connector socket for an additional cartridge. Studley teaches of a control cartridge selection device in which additional cartridges are connectable to a microcomputer at the same time (See Studley Fig. 3) [claim 2]. It would have been obvious to one of ordinary skill in the art to have multiple cartridges be connectable to the microcomputer of Hsu at the same time through multiple connector sockets. By connecting multiple cartridges at the same time, the player can select which game program they wish to play and are not burdened by having to constantly switch game cartridges, thereby, providing game play a moments notice.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, in view of Ohara, Re. 35,786. Hsu lacks in disclosing that the microcomputer includes a screen and a keypad. Ohara teaches of a gaming apparatus in which the portable microcomputer includes a screen and a keypad with at least control keys (See Ohara Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a screen and keypad with the invention of Hsu. While the game machine of Hsu is portable, the television is not as easily portable. Therefore, by having the screen, computer and keypad all contained in one compact unit, a player can travel easily with the gaming machine and be entertained almost anywhere.

Citation of Relevant Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Nagano et al., U.S. Patent No. 5,556,108.

--Nagano teaches of connecting two cartridges of different sizes.

2. Naka et al., U.S. Patent No. 5,941,775.


--Naka et al. discloses connecting two cartridges in a gaming device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Julie K Brockett
Primary Examiner
Art Unit 3713